

REMARKS

Amendment After Final

Entry of this Response is respectfully requested on the ground that this Response places the application in condition for allowance. Alternatively, entry of this Response is respectfully requested on the ground that this Response places the claims in better form and condition for appeal. Furthermore, Applicant submits that any discussion made with respect to the claims herein does not require an additional search on the part of the Office, nor does any discussion made herein raise new issues, in light of the prior art, with regard to the patentability of the claims now pending.

Further, Applicant respectfully submits that, in Applicant's previous Response, Applicant respectfully requested the specific citations that provided the motivation and reasonable expectation of success for the 35 U.S.C. 103 rejection. MPEP § 2143.01; Al-Site Corp. v. VSI International, 174 F.3d 1308, 50 USPQ.2d 1161 (Fed. Cir. 1999); In re Fine, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992). The fact that the Examiner has failed to provide such citations renders **the present Official Action an improper Final Action**. MPEP § 706.07 ("Before final rejection is in order a clear issue should be developed between examiner and applicant.").

Claim Rejections:

In an effort to fully respond to the Official Action, the rejections based on 35 USC 112 and 35 USC 103(a) are addressed hereinbelow.

Claim Rejections Pursuant to 35 U.S.C. 112

35 USC §112 Paragraph 2 recites:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

MPEP §2171 recites in relevant part:

If a rejection is based on 35 USC §112, second paragraph, the examiner should further explain whether the rejection is based on indefiniteness or on the failure to claim what applicants regard as their invention. Ex parte Ionescu, 222 USPQ 537, 539 (Bd. App. 1984).

Claims 2-9, 14-19, 58, and 60-75 stand rejected under 35 U.S.C. 112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the phrase “degradation resistant over extended time” is asserted in the Official Action as being indefinite. Claims 58, and 60-62, are canceled herein.

As stated in a previous Office Action response:

“During the Interview with the Examiner, Applicant noted that the present invention is directed to a pad that may be placed in solution, such as in a shelf-stored medicated solution, over an extended period of time, and, as such, the pad evidences highly absorbent properties without degradation due to extended exposure to such solutions. In accordance with the suggestions of the Examiner, new claims 63 and 74, and now amended claim 58 of the instant application, clarify that the non-woven pad displays high absorbency properties that allow the material to absorb large quantities of solution over time without substantial degradation of the material. Applicant submits that certain paper products, such as the paper towel disclosed in McFarland and the diaper backsheet disclosed in Schleinz, would suffer substantial degradation in instances necessitating high absorbency levels over extended time periods.”

As it is commonly known that paper towels and paper diaper materials, as disclosed in McFarland and Schleinz, may tear or otherwise physically fall apart (i.e., are not “resistant” to “degradation,” upon being soaked in liquid, for extended, non-fleeting periods of time, such as over the course of hours or days) it is respectfully submitted that the claims of the present invention make clear that the claims are directed to materials that do not exhibit such degradation characteristics. Thus, the present Amendment provides clear terminology consistent with the terminology in the prior art, thereby avoiding indefiniteness to one of ordinary skill in the art, see, e.g., Andrew Corp. v. Gabriel Electronics, Inc., 847 F.2d 819, 6 USPQ.2d 2010 (Fed. Cir. 1988); In re Mattison, 509 F.2d 563, 184 USPQ 484 (CCPA 1975); MPEP § 2173.05(b), and thereby complying with the agreement reached in the Interview of September 4, 2001 in the parent case.

Applicant further respectfully submits that, in the previous Applicant Response, dated July 30, 2002, Applicant points out that Sontara® fabric type S-8100 is specifically taught in the application as a fabric that is “degradation resistant.” As would be apparent to one of ordinary skill, particularly in light of an Information Disclosure Statement submitted on October 25, 2001, the SONTARA fabric properties include:

Absorbency—Since Sontara® Technologies fabrics can be made with a variety of fibers, the ability to absorb various liquids can be controlled without the use of surface modifying agents. That's why our 100% polyester styles offer excellent solvent absorbing properties — and our cellulosic/polyester and rayon/polyester styles are outstanding for absorbing aqueous liquids.

Strength & durability—Sontara® Technologies fabric has exceptional resistance to tearing, and maintains over 75% of its strength when wet. In addition, our spunlaced fabrics offer high machine/cross directional strength ratios.

This exemplary description highlights the absorbency, strength, and durability, over time, of the present invention, such as the maintenance over time of 75% of absorbent strength even when wet.

Consequently, Applicant asserts that one skilled in the art, in light of the teachings of the specification, would take **the phrase “degradation resistant” in the claims to mean a fabric having properties similar or equivalent to those of the Sontara® fabrics taught as a non-limiting example in the specification.** The maintenance of 75% of non-degradation, even when wet, provided by a fabric having properties similar or equivalent to the non-limiting example of the Sontara® fabrics taught in the specification as “degradation resistant”, is a maintenance of degradation resistance not known in the prior art in applications such as that claimed in the instant application. Therefore, Applicant asserts that the phrase “degradation resistant”, in light of the teachings and non-limiting examples of Applicant’s specification, see, e.g., Andrew Corp. v. Gabriel Electronics, Inc., 847 F.2d 819, 6 USPQ.2d 2010 (Fed. Cir. 1988); In re Mattison, 509 F.2d 563, 184 USPQ 484 (CCPA 1975); MPEP § 2173.05(b), is clearly definite to one of ordinary skill in the pertinent arts. **Thus, the term “degradation resistant” is clearly enabled and described by the specification, and is clearly definite to one of ordinary skill in the art as meaning a fabric having degradation resistance properties similar to, or equivalent to, Sontara® fabrics, which degradation resistant properties of Sontara® fabrics are clearly taught to one of ordinary skill, at least by the technical specifications of those Sontara® fabrics.**

With respect to the phrase “over extended time”, Applicant submits that, particularly in light of the technical specifications of the exemplary Sontara® fabrics taught in the instant specification, it would be apparent to one skilled in the art that the phrase “extended time” as

claimed is a matter of degree, and this phrase would be understood by one skilled in the art as being limited to non-fleeting periods of time, and would not include those fleeting periods of absorbency and durability over which the materials in the cited art, such as the diapers and paper towels in McFarland and Schlein, would degrade. Further, the previously filed Information Disclosure Statement illustrates that the Sontara fabrics may be used repeatedly, thereby illustrating that the durability and absorbency of the fabric is maintained indefinitely, and, thus, for an “extended time”, unlike the materials of McFarland and Schlein.

Applicant notes that the phrase “over extended time” refers to the time frame during which the claimed fabric resists degradation, and, as discussed herein, is thus limited to non-fleeting periods of time, and thus does not include fleeting periods of time in which degradation may occur, such as those in McFarland and Schlein. **Applicant respectfully submits that “extended time” is a term definite to those skilled in the art as meaning the length of time that a product might be exposed to a wet environment and necessitate non-degradation, such as in a medical container application.** In such an instance, the fabric claimed must resist degradation for at least the shelf life of the product, which would be clear to one skilled in the art as a non-fleeting time period, but which would vary by the shelf life of the product in which the present invention is applied. Such a resistance to degradation during the usable shelf life period of a medication, for example, is clearly a claim limitation, and is a claim limitation definite to those skilled in the art in light of the non-limiting examples provided in the instant specification.

Applicant notes that, if one skilled in the art can assess the meaning of “extended time” without undo experimentation, the phrase is not indefinite. Orthokinetics v. Safety Travel Chairs Inc., 1 USPQ2d 1081,1088 (CAFC 1986). This definiteness, if evident in the specification, does not require, as was requested in this Official Action, an actual reduction to practice, or

experimental data. Id. The lack of any requirement to provide experimental data is particularly evident where, as in the instant case, specific examples are provided within the specification. Id. The non-limiting example discussed above would provide an definition of “extended time” adequate to enable one of ordinary skill to assess the limitations of the claim without undue experimentation.

Applicant has, at no point, asserted that the claimed invention will “never” degrade. Rather, Applicant respectfully submits that the exemplary fabric pad taught in the instant application, namely the Sontara® pad, is durable and tear-resistant, and hence is “degradation resistant,” even when wet, such as in the medical application taught in the instant invention, over “extended time”, such as the non-fleeting time period for which such fabric must soak in a medicine for a medicinal application. Consequently, Applicant respectfully submits that the property of durability over non-fleeting time periods is not relative, but rather is a function of, for example, the shelf life of a given application (e.g. a medicinal or other application), and thus this property does have a definite meaning, at least in light of the exemplary Sontara® fabric provided in the specification.

With respect to the statement in the Office Action that the term “substantially non-leeching” is a relative term, and hence is indefinite, Applicant respectfully submits that the term is defined by the specification throughout, and is a required limitation of the combinations of inks and fabrics as claimed. For example, the specification teaches generally that a pad, having certain degradation resistance properties for extended time periods when wet, may have placed thereon special inks, which, when placed in combination with the pad, in a wet environment, do not allow more than a very small fraction of the ink to leech off, or through, the fabric pad. This characteristic is a direct result, and thus is a direct claim limitation, on the types of inks, and

pads, that may be used in order to obtain the invention as claimed, and is definite to one skilled in the art based, at least in part, upon the non-limiting exemplary inks and fabrics provided for in the instant specification. Further, the term “substantial” is a definite claim term, in accordance with court holdings and the MPEP. Andrew Corp. v. Gabriel Electronics, Inc., 847 F.2d 819, 6 USPQ.2d 2010 (Fed. Cir. 1988); In re Mattison, 509 F.2d 563, 184 USPQ 484 (CCPA 1975); MPEP § 2173.05(b).

Therefore, Applicant respectfully submits that Claims 2-9, 14-19, 58, and 60-75 are now in condition for allowance.

Claim Rejections Pursuant to 35 U.S.C. 103(a)

35 USC 103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

MPEP 706.02(j) recites:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner rejects claims 2-9, 14-19, 58, and 60-75, pursuant to 35 U.S.C. 103(a), as unpatentable over either McFarland et al (6096412), or Schleinz et al (5458590), in view

of either Dainippon (JP-63091234A), Hayashi (5776854), or Morikawa et al (6161928) and Desie et al (5,984,443). Applicant has herein canceled claims 58, and 60-62.

Applicant respectfully submits that, in order to establish a prima facie 35 USC §103(a) rejection, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. MPEP 706.02(j). “The examiner can satisfy the burden of showing obviousness of the combination only by **showing some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art** would lead that individual to combine the relevant teachings of the references.” (emphasis added) In re Sang Su Lee, 00-1158, (Serial No. 07/631,240) , (Fed.Cir.2002) citing In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed.Cir.1992). Further, to establish a prima facie 35 USC §103(a) rejection **there must be a reasonable expectation of success**. MPEP 706.02(j). **Mere motivation is not sufficient.** In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and **may not be based on Applicant's disclosure.** In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Official Action states that it would have been obvious to a person having ordinary skill in the art to utilize and/or combine the vehicles taught by Dainippon, Hayashi, and Morikawa into the dyes of McFarland and Schleinz, due to a motivation “to provide the ink with more uniform dispersion and improved mechanical strength.” However, Applicant again respectfully notes that this motivation is **not specifically from within the references, or specifically shown as being apparent to one of ordinary skill in the art.** Applicant

respectfully submits that a proper 35 USC §103(a) rejection requires **not that the Examiner provide the Examiner's motivation for the prior art combination asserted**, but rather that **the motivation from within the prior art itself be provided for the combination cited**. MPEP § 2143.01; Al-Site Corp. v. VSI International, 174 F.3d 1308, 50 USPQ.2d 1161 (Fed. Cir. 1999); In re Fine, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992). Applicant respectfully submits that **the prior art does not provide any motivation for the cited combination**, and that the only motivation provided to make the cited combination has been that of the Examiner.

Further, as noted in this Official Action, Applicant has submitted that the long felt need for a fabric pad having substantially non-bleeching ink that is degradation resistant over extended time has been resolved by the claimed invention. See Declaration of Dean Shacklett. Were a motivation provided to combine the ink and pad as claimed present in the prior art, such a combination would already have been made by those skilled in the art in order to meet this long felt need. Were there a reasonable expectation of success that this combination of cited art would meet this long felt need, presumably one skilled in the art would have already created such a combination. Thus, the lack of such a combination, in light of the long felt need, leads to a presumption that the present invention is not obvious. Therefore, Applicant again respectfully submits that **no specific support** has been provided to suggest that one of skill in the art would have combined, or would have been motivated to combine, the references as set forth in the Official Action. Applicant again respectfully submits that, should the Examiner disagree, the Examiner provide **specific support, from the prior art cited**, that the motivation existed **in the prior art** to combine the references to meet the long felt need cited by Applicant.

The Federal Circuit, with regard to 35 USC §103(a) obviousness rejections, has made it clear that “[t]he need for specificity pervades.” See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir.2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner *claimed*” [emphasis added]). **In the instant case, no specificity has been provided** to support that one of skill in the art would have combined, or would have been motivated to combine, the relevant teachings of the references in the manner *claimed*, as has been repeatedly required by the Federal Circuit. “The factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.” In re Sang Su Lee, (Fed.Cir.2002).

For example, the Official Action states that the combination of McFarland or Schleinz, and/or in Dainippon, Hayashi, or Morikawa, does not explicitly teach forming an image on both sides of a pad in register, but that Desie could be combined with this combination to make the requisite teaching, due to the fact that a skilled artisan “would have been motivated to select the printing process of Desie by the desire to achieve high quality printing at higher speeds”. Applicant respectfully submits that **no such motivation is discussed anywhere in the cited art, nor is there discussed any suggestion that such a combination would have a reasonable likelihood of success.** Desie discloses the use of electrostatic printing, which would not be operable with the inks and fabrics provided for in the present invention. Applicant respectfully submits that the printing process provided by Desie would not provide a printed result that was substantially non-bleeding and degradation resistant over extended time in a wet environment, and hence specifically teaches away from the invention as claimed. Desie would be inoperable, for example, in a medical application in which the printed pad was soaked for an extended period

of time. Hence, Desie cannot be combined with the cited art. Rather, Desie teaches away from the use of the invention as claimed. Applicant respectfully submits that a Section 103 rejection is improper when the cited art references are specifically taught as non-combinable. MPEP § 2143.01; Al-Site Corp. v. VSI International, 174 F.3d 1308, 50 USPQ.2d 1161 (Fed. Cir. 1999); In re Fine, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992).

Further, Applicant notes that the only motivation to make the claimed invention, other than Examiner's statements, appears to be within Applicant's own specification and claims, in direct contrast to the holding of In re Vaeck, discussed above. Such a combination could not and did not, due to a lack of motivation and reasonable expectation of success, exist outside of Applicant's specification and claims, as evidenced by the long felt need for such a non-leeching ink and degradation resistant ink and pad combination discussed in the previously submitted Declaration of Dean Shacklett. Without a suggestion to combine and a reasonable expectation of success outside of Applicant's own specification and claims, Applicant respectfully submits that **a claimed invention cannot be obvious based merely on an Examiner's assertion that it would have been "obvious [or desirable] to try."** Amgen, Inc., v. Chugai Pharmaceutical. Co., Ltd., 927 F.2d 1200 (Fed.Cir.1991).

The Federal Circuit, in In re Sang Su Lee, 00-1158, (Serial No. 07/631,240), (Fed Cir. 2002), reversed a rejection based on a motivation to combine. "Bozek did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. Bozek did not hold that objective analysis, proper authority, and reasoned findings can be omitted ... Nor does Bozek, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and Court of Customs and Patent Appeals that

determination of patentability *must be based on evidence.*" (emphasis added). Applicant respectfully submits that no objective evidence has been set forth in the Official Action as to any suggestion or motivation to combine the references as cited in the present Office Action, or that such a combination might present a reasonable expectation of success, and that this lack of evidence is adverse to the decision in Sang Su Lee.

Applicant thus respectfully submits that the skilled artisan would have found no motivation to combine the referenced teachings in the manner asserted, as the cited art itself provided neither a statement of such motivation, nor any evidence that such combination would have a reasonable likelihood of success. Applicant notes that the sole motivation provided appears to be that provided by the Examiner, not that provided in the prior art. **Applicant again respectfully requests that, should the Examiner persist in the assertion that such motivation and reasonable expectation of success exists, and if the Examiner thereby intends to take judicial notice of such motivation and expectation of success, that the Examiner provide some evidence in the prior art that such a motivation and reasonable expectation of success is present in the prior art.**

With respect to the statements in the Official Action regarding Applicant's Declaration submitted in Response to the previous Official Action, Applicant submits that the submitted Declaration suggested a long-felt need, addressed solely by the invention claimed in the instant application, as evidenced by the commercial success of the instant application. Declaration of Dean Shacklett. Applicant notes, with respect to the statement in the Official Action that no declarations have been provided from the requesting company of this pad, or by competitors in this field, in support of the Declaration of Dean Shacklett, that such a declaration is not required. A declaration is not required from all parties involved in the existence of a long felt need, but

rather is only required from a skilled artisan who has experienced the long felt need. 37 C.F.R.

1.132. Such a declaration from a skilled artisan has been properly provided by Applicant. See Declaration of Dean Shacklett. Applicant therefore respectfully submits that no further declaration is necessary. Further, Applicant respectfully submits that the Declaration does indeed provide evidence that the long felt need was persistent, as the Declaration, in combination with the lengthy history of prior art in this art provided in the Official Actions, evidences that while such art has existed for a very long time, the need filled by the claimed invention has never been met, **nor has a motivation to combine art in the manner claimed to meet the need been specifically expressed in any cited art.**


Therefore, Applicant respectfully submits that Claims 2-9, 14-19, and 63-75 are now in condition for allowance.

Conclusion

Applicant respectfully requests consideration of the subject application in light of the reasons set forth herein. Consequently, a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,

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